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10/051,557	01/16/2002	Daniel Roy Schlee	74331.000004	9638
21967 7590 06/23/2009 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
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NGUYEN, TRI V				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/051,557

Applicant(s)

SCHLEE, DANIEL ROY

Examiner

TRI V. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-66 is/are pending in the application.
- 4a) Of the above claim(s) 66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/24/09 has been entered.

Response to Amendment

1. Upon entry of the amendment filed on 03/24/09, Claims 48, 49, 52, 53, 56 and 57 are amended, claim 66 is withdrawn, Claims 58-66 are added and Claims 1-47 are cancelled. The currently pending claims are Claims 48-66.

Election/Restrictions

2. Newly submitted claim 66 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 66 is directed to a tracking process and mechanism that is absent in the original claimed invention that is directed solely towards a targeted couponing process.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 66 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 59, 60, 63 and 64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 59 and 63, lines 3-5, there seems to be no literal basis for the claim limitation of the third party providing information for consumers that are unable to connect to a computer network. .

In claims 60 and 64, there seems to be no literal basis for the claim limitation of non-specific retailer.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 48, 49, 52, 53, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (US 2004/0220854) in view of Barnett et al. (US 6321208), the GMA press release, the Ewoldt article and Katz et al. (US 6055513).

Claim 48: Postrel discloses a method comprising the steps of:

- a) providing a database in a host computer system, the database to comprise personal and demographic data associated with a plurality of consumers, the personal and demographic data

for each respective consumer to originate from at least one of: each respective consumer and a third party (Postrel: § 11, 15, 18, 34 and 37 – Figure 1); and

b) interfacing between the host computer system and one or more of the plurality of consumers, wherein the host computer system and the one or more of the plurality of consumers are separate entities, the interfacing comprising:

b. 1 inputting, by the one or more of the plurality of consumers, personal and demographic data associated with the one or more of the plurality of consumers (Postrel: § 15, 16);

c) interfacing between the host computer system and one or manufacturers, wherein the host computer system and the one or more manufacturer are separate entities, the interfacing comprising:

i) inputting, by each manufacturer, information comprising: manufacturer data comprising textual and image content associated with the manufacturer; a Uniform Code Council (UCC) code assigned to the manufacturer; brand name data; and product data comprising: a UCC code assigned to each product of the manufacturer; and content for each product comprising textual and image content for each product, wherein the textual and image content for each product further comprises a product description, a brand name, and a product size indicia (Postrel: § 11, 15, 18, 34 and 37);

ii) inputting, by each manufacturer, data for consumer selection comprising: textual and image content associated with the manufacturer; textual and image content associated with a product of the manufacturer; and a 3-party manufacturer coupon to purchase a tangible product that is manufactured by the manufacturer comprising: the UCC code assigned to the manufacturer; the UCC code assigned to each product of the manufacturer; a UCC manufacturer coupon family code; a UCC manufacturer coupon

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- value code; a UCC manufacturer coupon extended bar code; a manufacturer coupon offer code; a description of one or more products required to be purchased to redeem the promotional material; and a manufacturer coupon expiration date;
- iii) inputting, by each manufacturer, one or more manufacturer target consumer profiles comprising: gender; age; delivery interval; and one or more zip code regions for promotional material delivery (Postrel: § 11, 15, 18, 34 and 37);
- iv) specifying, by each manufacturer, content for the manufacturer coupon comprising: the UCC code assigned to the manufacturer; the UCC code assigned to each product of the manufacturer; the UCC manufacturer coupon family code; the UCC manufacturer coupon value code; the UCC manufacturer coupon extended bar code; the UCC manufacturer coupon offer code; the description of one or more products required to be purchased to redeem the manufacturer coupon; and the expiration date;
- v) querying the database to obtain manufacturer query results based at least in part on the personal and demographic data associated with the one or more of the plurality of consumers; and
- vi) forming a list of manufacturer consumers from the manufacturer query results to receive the promotional coupon, the list including a representative manufacturer consumer having a manufacturer consumer identification; and
- d) generating the manufacturer coupon by the host computer, as directed solely by the manufacturer, the manufacturer coupon comprising: the UCC code assigned to the manufacturer; the UCC manufacturer coupon family code; the UCC manufacturer coupon value code; the manufacturer coupon extended barcode; a manufacturer/military coupon indicator; the manufacturer coupon expiration date; the manufacturer coupon offer code; and a manufacturer coupon consumer identification code corresponding to a respective manufacturer consumer

identification comprising a serial number and a bar code representation of serial number to identify one or more of the manufacturer consumers, wherein data required to generate the 3-party manufacturer coupon is available only to the host system and is not distributed to any entity outside of the host computer system (Postrel: § 28 and 34); and

e) distributing the 3-party manufacturer coupon using the host computer, as directed by the manufacturer, to a physical address of the one or more registered manufacturer consumers (Postrel: § 11, 15, 18, 34, 37 and 62); and

f) redeeming the 3-party manufacturer coupon at a retailer by the one or more registered manufacturer consumers; wherein the retailer and the one or more manufacturer are separate entities (Postrel: § 11, 15, 18, 34 and 37).

Claim 49: Postrel discloses the method of claim 48, the method further comprising the steps of:

g) interfacing between the host computer and one or more retailers, the interfacing comprising:

i) inputting, by each retailer, consumer selection information comprising: retailer data comprising textual and image content associated with the retailer; a retailer coupon offer code; and a retailer coupon value (Postrel: § 11, 15, 18, 34 and 37);

ii) inputting one or more retailer target consumer profiles comprising: gender, age, zip code region, and delivery interval;

iii) specifying, by each retailer, content for a retailer coupon comprising: the retailer offer code; a retailer expiration date; and the retailer coupon value (Postrel: § 11, 15, 18, 34 and 37);

iv) querying the database to obtain retailer query results based at least in part on the personal and demographic data associated with the one or more of the plurality of consumers; and (Postrel: § 11, 15, 18, 34 and 37);

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- v) forming a list of retailer consumers from the retailer query results to receive the 2-party retailer coupon, each of the retailer consumer having a retailer consumer identification (Postrel: § 11, 15, 18, 34 and 37);
- h) generating the retailer coupon by the host computer system, as directed solely by the 2-party retailer, the retailer coupon comprising:
 - i) the retailer coupon offer code;
 - ii) the retailer coupon expiration date; and
 - iii) a retailer coupon consumer identification code corresponding to a respective retailer consumer identification comprising a serial number and a bar code corresponding to a retailer consumer identification comprising a serial number and a bar code representation of the serial number to identify one or more of the retailer consumers;
- c) distributing the retailer coupon using the host computer, as directed by the retailer, to a physical address of the one or more retailer consumers (Postrel: § 11, 15, 18, 34 and 37); and
- d) redeeming the retailer coupon at the retailer by the one or more retailer consumers.

Claim 56: The method of claim 48, wherein the step of interfacing between the host computer and one or more consumers further comprises:

offering the manufacturer coupon via an online interface for selection by the one or more consumers; and

recording a selection of the manufacturer coupon made by the one or more consumers (§ 12, 28 and 30).

Thus, Postrel teaches the process of distributing customized coupons targeted to consumer based on inputs by the offering companies and registration data (demographic, travel destinations, occupations, ...) provided by the consumers that includes various participating

entities and packages with services and products (Postrel: § 11, 15, 18, 24, 34, 37 and 67). Postrel teaches the adaption of the process to provide coupons for products and services to be redeemed at various point of sales – clothing stores, gift shops, hotels and stores which can be construed as meeting the retailing criteria (§ 22, 24 and 62). Furthermore, Postrel discloses the feature of the push and pull couponing schematic in which the offering companies and consumers are respectively controlling the selection of the coupons (§ 12, 28 and 30). However, Postrel does not explicitly disclose the features of a manufacturer/retailer coupon, textural or image contents, a targeted profile based on various criteria such as age, gender or zip code regions, the third party database and the various databases schematics. In an analogous art, Barnett et al. disclose a process of distributing manufacturer and retail coupons targeted to subscribed customers based on profiling features such as location/zip code and demographics (Barnett et al.: abstract; col 1, lines 21-32, col 4, lines 34-38; col 9, lines 46-53; col 10, lines 17-31 and col 12, lines 26-65). In Figure 5, Barnett et al. show the graphics and textual content of a manufacturer's coupon. The GMA reference teaches the feature of coupon standards (pages 1 and 2). The Ewoldt reference teaches that retail and manufacturer coupons are well known (page 1). The Katz et al. reference teaches the feature of using databases entries and schematics in the process of distributing coupons to users based on correlation between demographics data provided by the user, by third parties and by the manufacturer (col 13, line 36; col 17, line 37 to col 18, line 50; col 19, line 58 to col 20, line 22 and col 23, lines 1-60). The claims would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan. The adaptation of the coupon distribution method to specific practices would be well within the purview of skill artisan in the art of marketing at the time of the invention. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Postrel with the

manufacturer and retail coupon distribution features taught by Barnett et al., GMA, Ewoldt and Katz et al. One would have been motivated to gain higher consumption rates via the distribution of coupons to targeted audience via the accumulation of pertinent data and to restrict or define a specific geographical region in the distribution of the coupons for marketing purposes (e.g. targeted promotional campaign).

Regarding the targeted couponing by retailer, it would have been obvious to a skilled artisan to adapt the method of distributing the coupons by utilizing the same criteria in the decision process gain the benefit of more accurate customized offers and streamlined data flows.

It is noted that the limitations of a product and retailer are deemed to be met by the products and discount coupon at the stores, hotel and gift shops taught by Postrel (§ 22, 24) and the adaption via the teachings of Barnett, Katz et al. and Ewoldt.

Claim 58: Postrel, Barnett, GMA, Katz et al. and Ewoldt disclose the coupon distribution method but do not explicitly disclose further comprising:

receiving at the host computer system, from the third party, personal and demographic data associated with one or more of the plurality of consumers, wherein the one or more of the plurality of consumers and the third party are separate entities. Katz et al. teach the feature of using third party databases and entries (Katz et al.: col 17, line 65 to col 18, line 15). Thus it would have been obvious to a skilled artisan at the time of the invention to enhance the customization of the coupon via accessing pertinent databases outside sources.

Claim 59: Postrel, Barnett, GMA, Katz et al. and Ewoldt disclose the coupon distribution method but do not explicitly disclose wherein the third party provides the personal and demographic

data for at least one of the plurality of consumers that is unable to connect to a computer network, does not have access to a computer network, or has no relationship with the host computer system. Katz et al. teach the feature of using third party databases and entries (Katz et al.: col 17, line 65 to col 18, line 15). Thus it would have been obvious to a skilled artisan at the time of the invention to enhance the customization of the coupon via accessing pertinent databases from outside sources.

Claim 60: Postrel, Barnett, GMA, Katz et al. and Ewoldt disclose the coupon distribution method of claim 48, wherein the one or more manufacturer consumers are not required to redeem the 3-party manufacturer coupon at a specific retailer identified on the 3- party manufacturer coupon (Postrel: § 22, 24 and 62). Furthermore, Ewoldt teach the use of coupon at various retailers (page 1). Thus it would have been obvious to a skilled artisan at the time of the invention to modify the method of Postrel to include the non-specific retailer option to gain the benefit of a higher rate of coupon consumption via the user being able to access greater number of outlets for redemption.

Claim 61: Postrel, Barnett, GMA, Katz et al. and Ewoldt disclose the coupon distribution method of claim 48, wherein the one or more manufacturer consumers are allowed to redeem the 3-party manufacturer coupon at a retailer who does not have a relationship with the host computer system (Postrel: § 22, 24 and 62 – the gift shop is construed to be outside the host system).

Claims 52, 53, 57 and 62-65 describe the system of the method of Claims 48, 49, 56 and 58-61 respectively; thus, the prior art of Postrel, Barnett, GMA, Katz et al. and Ewoldt as set forth above are relied upon to reject Claims 52, 53, 57 and 62-65.

6. Claims 50, 51, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel in view of Barnett, GMA, Katz et al. and Ewoldt and further in view of Gupta et al.

Postrel, Barnett, GMA, Katz et al. and Ewoldt disclose the coupon distribution method but do not explicitly disclose the feature of nutritional data associated with the coupon. In an analogous art, Gupta et al. disclose the feature of a nutritional data in the process coupon distribution (col 1, lines 15-36). The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan. The adaptation of the coupon distribution method to specific product would be well within the purview of skill artisan in the art of marketing at the time of the invention.

Claims 54 and 55 describe the system of the method of Claims 50 and 51 respectively; therefore, the prior art of Postrel, Barnett, GMA, Katz et al., Ewoldt and Gupta as set forth above are relied upon to reject Claims 54 and 55.

Response to Arguments

7. Applicant's arguments with respect to claims 1-65 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRI V. NGUYEN whose telephone number is (571)272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. V. N./
Examiner, Art Unit 1796
June 23, 2009

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622